

Remarks

By the foregoing amendments, claims 17, 19, 20, 36, 38 and 39 have been cancelled without prejudice or disclaimer thereto. Claims 2, 18, 21, and 37 are sought to be amended. Support for the amendments to the claims can be found throughout the specification. Accordingly, these amendments do not add new matter, and their entry and consideration are respectfully requested. Upon entry of the foregoing amendments, claims 2-16, 18, 21-35 and 37 are pending in the application, with claims 2 and 21 being the independent claims.

Rejection Under 102(e) over Griffiths

In the Office Action at pages 2-3 the Examiner has rejected claims 2-6, 8-13, 15-18, 21-25, 27-32 and 34-37 under 35 U.S.C. § 102(e) as allegedly being anticipated by Griffiths *et al.*, U.S. Patent No. 6,010,884 (hereinafter "Griffiths"). Applicants respectfully traverse this rejection. However, solely to expedite prosecution, and not in acquiescence to this rejection, claims 17 and 36 have been canceled. Hence, the portion of this rejection that may have applied to these claims has been rendered moot. Applicants respectfully traverse this rejection as it may apply to the remaining claims.

The Examiner contends that Griffiths discloses the various elements of the rejected claims. Applicants respectfully disagree with this contention.

Applicants respectfully submit that Griffiths does not disclose a composition as recited in claim 2 (and hence, claims 3-16 and 18 that depend ultimately therefrom). Specifically, Griffiths does not disclose a composition comprising at least two *different* isolated recombination proteins. Applicants also submit that Griffiths does not disclose a kit as recited in claim 21 (and hence, claims 22-35 and 37 that depend ultimately therefrom). Specifically, Griffiths does not disclose a kit comprising at least two *different* isolated

recombination proteins. Hence, Griffiths does not disclose every element of the presently claimed invention, and therefore Griffiths cannot and does not anticipate the presently claimed invention under 35 U.S.C. § 102(e).

In view of the foregoing remarks, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 2-6, 8-13, 15-18, 21-25, 27-32 and 34-37 under 35 U.S.C. § 102(e).

The Rejection Under 35 U.S.C. § 103(a) Over Griffiths In View Of Baum

In the Office Action at page 4 the Examiner has rejected claims 2-6, 8-18, 21-25, and 27-37 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Griffiths in view of Baum, *et al.*, *J. Bacteriol.* 176:2835-2845 (1994) (hereinafter "Baum"). Applicants respectfully traverse this rejection. However, solely to expedite prosecution, and not in acquiescence to this rejection, claims 17 and 36 have been canceled. Hence, the portion of this rejection that may have applied to these claims has been rendered moot. Applicants respectfully traverse this rejection as it may apply to the remaining claims.

The Examiner asserts that Griffiths discloses the various elements of the presently claimed invention, but does not disclose a recombination protein encoded by *B. thuringiensis*. The Examiner states that Baum discloses recombination proteins encoded by *B. thuringiensis* and asserts that it would have been obvious to utilize such recombination proteins in the methods of Griffiths. The Examiner therefore concludes that the presently claimed invention is rendered obvious. Applicants respectfully disagree with these assertions and the Examiner's conclusion.

As noted above, Applicants respectfully submit that Griffiths does not disclose a composition comprising at least two different isolated recombination proteins, or a kit

comprising at least two different isolated recombination proteins, as recited in the present claims. Therefore, Griffiths is seriously deficient as a primary reference on which to base a *prima facie* case of obviousness. Baum does not cure these deficiencies in Griffiths, as Baum also does not disclose a composition or a kit comprising at least two different isolated recombination proteins.

Applicants respectfully submit that the Examiner has not met the burden of establishing a *prima facie* case of obviousness, as Griffiths, alone or in combination with Baum, does not render obvious the presently claimed invention. Therefore, in view of the foregoing remarks, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a).

The Rejection Under 35 U.S.C. § 103(a) Over Griffiths In View Of Savakis

In the Office Action at pages 5-6 the Examiner has rejected claims 2-13, 15-18, 21-32 and 34-37 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Griffiths in view of Savakis, *et al.*, U.S. Patent No. 6,225,121 (hereinafter "Savakis"). Applicants respectfully traverse this rejection. However, solely to expedite prosecution, and not in acquiescence to this rejection, claims 17 and 36 have been canceled. Hence, the portion of this rejection that may have applied to these claims has been rendered moot. Applicants respectfully traverse this rejection as it may apply to the remaining claims.

The Examiner asserts that Griffiths discloses the various elements of the presently claimed invention, but does not disclose a second nucleic acid molecule comprising at least one toxic gene and at least one selectable marker on different nucleic acid segments, separated by at least one recombination site. The Examiner states that Savakis discloses a vector comprising a toxic gene and a selectable marker gene, separated by a recombination

site, and the usefulness of these components in selection procedures in genetic recombination systems. The Examiner further asserts that it would have been obvious to combine the disclosure of Griffiths and Savakis to cure the deficiencies noted in Griffiths. The Examiner therefore concludes that the presently claimed invention is rendered obvious. Applicants respectfully disagree with these assertions and the Examiner's conclusion.

As noted above, Applicants respectfully submit that Griffiths does not disclose a composition comprising at least two different isolated recombination proteins, or a kit comprising at least two different isolated recombination proteins, as recited in the present claims. Therefore, Griffiths is seriously deficient as a primary reference on which to base a *prima facie* case of obviousness. Savakis does not cure these deficiencies in Griffiths, as Savakis also does not disclose a composition or a kit comprising at least two different isolated recombination proteins.

Applicants respectfully submit that the Examiner has not met the burden of establishing a *prima facie* case of obviousness, as Griffiths, alone or in combination with Savakis, does not render obvious the presently claimed invention. Therefore, in view of the foregoing remarks, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a).

The Obviousness-Type Double Patenting Rejection Over Hartley

In the Office Action at pages 6-7, the Examiner has rejected claims 2 and 21 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 5 and 14 of commonly owned U.S. Patent No. 6,720,140, Hartley *et al.* (hereinafter "Hartley"). Applicants respectfully traverse this rejection. However, solely to expedite prosecution, and not in acquiescence to this rejection, Applicants have incorporated

all of the features recited in non-rejected dependent claims 19 and 38 into claims 2 and 21 respectively. Hence, this rejection has been rendered moot. Therefore, Applicants respectfully request reconsideration and withdrawal of this rejection.

The Claim Objections

In the Office Action at page 7, the Examiner has objected to claims 19, 20, 38 and 39, as being dependent upon a rejected base claim. The Examiner states, however, that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Applicants thank the Examiner for this designation of provisionally allowable subject matter. Applicants believe that the present claims are allowable as the Examiner has indicated. Specifically, present claim 2 incorporates the features recited in canceled claim 19. Similarly, present claim 21 incorporates the features recited in canceled claim 38. Thus, Applicants respectfully contend that this objection has been accommodated.

Conclusion

All of the stated grounds of rejection and objection have been properly traversed, accommodated, or otherwise rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided. Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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